

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRENDON G. NUNES

Appeal No. 95-4546
Application 08/071,008¹

ON BRIEF

Before THOMAS, HAIRSTON, and TORCZON, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

¹ Application for patent filed June 2, 1993.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 23. After submission of the brief, the examiner found claims 21 and 22 to be allowable over the prior art of record (Answer, page 1). Accordingly, claims 1 through 20 and 23 remain before us on appeal.

The disclosed invention relates to a method and apparatus for using a computer and a color photocopier to produce a multicolor element with indicia thereon.

Claims 1 and 15 are illustrative of the claimed invention, and they read as follows:

1. A method of constructing a functional multicolor element having indicia thereon, utilizing a computer and a color photocopier, comprising the steps of:

(a) electronically creating or providing in the computer an electronic simulation of the desired functional multicolor element, with indicia thereon;

(b) under the control of the computer, transmitting electronic signals from the computer to the photocopier so that the photocopier transforms the electronic simulation of the desired functional multicolor element onto a piece of sheet material; and

(c) using the functional multicolor element with other elements to produce a functioning object.

15. Apparatus for producing multicolor instrument faces, comprising:

a computer;
a color photocopier;

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interface means for controlling said color photocopier with said computer to effect printing of a multicolor instrument face on a sheet of paper from electronic signals transmitted to said color photocopier from said computer; and

automatic cutting means operatively connected to said computer for cutting an instrument face shape from a sheet of paper on which it has been printed by said color photocopier.

The reference relied on by the examiner is:

Morofuji et al. (Morofuji) 5,065,183 Nov. 12, 1991

Claims 1 through 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Morofuji.

Claims 6 through 20 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morofuji.

Reference is made to the briefs, the answer, and the declarations (paper numbers 5 and 8) by appellant, Brendon G. Nunes, for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the 35 U.S.C. § 102(b) rejection of claims 1 through 3, reverse the 35 U.S.C. § 102(b) rejection of claims 4 and 5, sustain the 35 U.S.C. § 103 rejection of claims 8 and 10

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through 18, and reverse the 35 U.S.C. § 103 rejection of claims 6, 7, 9, 19, 20 and 23.

Evidence of secondary considerations submitted in the declarations must always be considered with respect to a rejection under 35 U.S.C. § 103, but such evidence is irrelevant where the reference is anticipatory of the claimed invention under 35 U.S.C. § 102(b). See In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). Without novelty, evidence of unobviousness is superfluous. See In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984).

Appellant's only argument with respect to the rejection of claim 1 under 35 U.S.C. § 102(b) is that "web 30 of Morofuji et al is clearly and unequivocally not a piece of sheet material" (Brief, paper number 16, page 7). The web or plastic film 30 in Figure 2 of Morofuji is a "sheet material," and the electrophotographic units 2, 3 and 4 transform "the electronic

simulation of the desired functional multicolor element onto a piece" of the plastic "sheet material" (column 12, line 55 through column 13, line 1). Thus, the 35 U.S.C. § 102(b) rejection of claim 1 is sustained.

The 35 U.S.C. § 102(b) rejection of claims 2 and 3 is sustained because the cut-off device 15 in Figure 2 of Morofuji is a laser that cuts the picture image from plastic sheet material 30 (column 13, lines 10 through 13). The severed picture image is then transferred and fused to the object 51 at station 5.

The 35 U.S.C. § 102(b) rejection of claims 4 and 5 is reversed because Morofuji does not teach a sheet material of paper and thus does not disclose step (e) of laminating a sheet of paper onto a piece of more rigid sheet material prior to the practice of step (d).

Turning to the obviousness rejection of claim 6, appellant argues that "[t]here is absolutely no suggestion whatsoever to one of ordinary skill in the art for any modification of Morifuji et al to provide the method of claim 6 wherein an instrument face is printed on a sheet of paper and then is assembled with mechanical and electrical components to produce an operable instrument" (Brief, paper number 16, page 10). We agree. The

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obviousness rejection of claim 6 is reversed, and the obviousness rejection of claims 7 and 23 is likewise reversed because these claims depend from claim 6.

Claim 8 on appeal requires the copying of an instrument face on a sheet material, and then cutting out the copied shape from the sheet of material. The examiner is of the opinion that the pictorial image stored by the computer in Morofuji "would have been any design desired to be photocopied by the user" onto the surface of the cans (Answer, page 6). In other words, it is the examiner's position that an instrument face (e.g., a clock face) can be copied onto the surface of a can in Morofuji.

The first declaration (paper number 5) submitted in rebuttal to the examiner's position with respect to claim 8 and the other claims found obvious by the examiner states in paragraphs 2 and 11 that the disclosed and claimed invention solved a long-felt need in the market for "the ability to quickly and cost effectively produce high quality instrument dials," "multi-colored clock dials or other instrument faces." The second declaration (paper number 8) indicates in paragraph 4 that "[t]he catalog of Exhibit E describes some of the significant commercial advantages of the products produced according to my invention and in my view supports my earlier declaration about the unobviouness

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and novelty of my invention." Turning first to the purported commercial success, appellant has not proven any nexus between the statements made by his competitor in the Exhibit E catalog and the claimed invention in claim 8. For this reason, appellant cannot use such statements to prove commercial success of his claimed invention. To prove long-felt need in the market, appellant has to submit evidence that his claimed invention filled a void in the marketplace that was not met by others in the industry. See In re Allen, 324 F.2d 993, 996-97, 139 USPQ 492, 495 (CCPA 1963). Appellant's opinions in the declarations which have little relevance to the claimed invention cannot take the place of such evidence. In view of the lack of convincing evidence of non-obviousness, we agree with the examiner that the pictorial image stored by the computer in Morofuji "would have been any design desired to be photocopied by the user" onto the surface of the cans, and that a clock face can be copied onto the surface of a can in Morofuji. The obviousness rejection of claim 8 is sustained.

The obviousness rejection of claim 10 is sustained because Morofuji uses a laser 15 to automatically cut a shape from the sheet of material 30 (column 13, lines 10 through 13). The obviousness rejection of claim 11 is sustained because it would

have been manifestly obvious to one of ordinary skill in the art to use paper in lieu of plastic film 30 in Figure 2 of Morifuji since it is conventional in the art to wrap paper labels around a can, and because Morifuji explains (column 12, line 55 through column 13, line 10) that the film 30 is in a laminated condition prior to the cutting step. The obviousness rejection of claims 12 through 14 is sustained because Morofuji can copy a limited number of a multicolored instrument face such as a clock onto the surfaces of cans.

The obviousness rejection of claim 9 is reversed because Morofuji neither teaches nor would have suggested the step of "assembling the instrument face with other functional components to produce an operable instrument having a face with functional indicia thereon."

With respect to claims 15 through 18, appellant argues (Brief, page 13) that "there is no disclosure seen in Morofuji et al for the particular interface means as recited therein to print a multi-color instrument face on a sheet of paper, or the automatic cutting means to cut the instrument face from the sheet of paper." For all of the reasons expressed supra in connection with claim 11, the obviousness rejection of claims 15 and 16 is sustained. The obviousness rejection of claim 17 is sustained

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because a scanner and/or a CD ROM were conventional sources of input data for a computer such as the one used by Morifuji. The obviousness rejection of claim 18 is sustained because Morifuji discloses (column 13, lines 10 through 14) that the cut-off device 15 is a laser cutter.

The obviousness rejection of claims 19 and 20 is reversed because we agree with appellant's argument (Brief, paper number 16, page 12) that Morifuji is not concerned with "superimposing functional indicia for an instrument face on a transparent substrate over a color photograph."

DECISION

The decision of the examiner rejecting claims 1 through 5 under 35 U.S.C. § 102(b) is affirmed as to claims 1 through 3, and is reversed as to claims 4 and 5. The decision of the examiner rejecting claims 6 through 20 and 23 under 35 U.S.C. § 103 is affirmed as to claims 8 and 10 through 18, and is reversed as to claims 6, 7, 9, 19, 20 and 23. Thus, the decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
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KENNETH W. HAIRSTON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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